

REMARKS

Reconsideration of the rejection set forth in the Office Action dated February 25, 2008, is respectfully requested. Claim 12 has been amended to require the method to consist essentially of certain steps. No new matter was added with this amendment.

Claims 12, 13, and 16-18 were rejected under 35 U.S.C. § 102 for alleged anticipation by Baumgartner. These rejections should be withdrawn for the following reasons.

Applicants have amended claim 12 to require “*said method consisting essentially of the steps of...*” (See *PPG Industries v. Guardian Industries Corp.*, 156 F.3d 1351, 1354 (Fed. Cir. 1998)) “Typically, ‘consisting essentially of’ precedes a list of ingredients in a composition claim or a series of steps in a process claim. By using the term ‘consisting essentially of,’ the drafter signals that the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention.”) By previous amendment, claim 12 is additionally limited to the step of “*inserting no more than one implant into the defect in the annulus fibrosis.*” Therefore, the method of claim 12 requires the insertion of only a single implant, *i.e.*, “*no more than one implant,*” and does not cover the situation in which multiple implants are inserted into the defect.

Baumgartner, by contrast, requires multiple implants be inserted into the disc space. (See, e.g., Col. 1, lines 41-48 “The object of the invention is to create a universal, simple to apply implant, which can be used as a support member for varied cavities formed at random. This object is achieved in accordance with the invention in that the implant contains at least three elastically deformable support members which can be inserted into the central cavity and can be positioned therein.” (emphasis added); *see also* the Abstract “An implant consisting of several

support members (7), which are produced from an elastic plastic, is provided as a replacement for a part, which is no longer capable of bearing loads, or the core region of an intervertebral disk (3). The support members (7) are inserted one after the other into a central cavity (5)” (emphasis added))

In fact, Baumgartner believed there would be problems with using only a single implant. (See Col. 1, lines 30-36 “As the surgeon has to work with predetermined implant sizes, he is forced to produce a matching cavity in the core region of the intervertebral disk. The known implant requires a relatively expensive design of the hollow member, in order to guarantee permanent tightness against the egress or fluid, which is required if the implant is to work optimally.”). By requiring multiple implants, Baumgartner can fill cavities of varying size by simply inserting additional implants. Therefore, Baumgartner actually teaches away from the step of “inserting no more than one implant into the defect in the annulus fibrosis” as required by the amended claims.

The Examiner has taken the position that Baumgartner “indeed discloses a singular (and last) implant *inserted through an elongate tubular member* as claimed, where the implant comprises a flexible device having a structure with at least two appendages (18 or 18’) as claimed.” (Office Action, Page 3) In other words, the Examiner has taken the position that Baumgartner describes inserting a single implant of a specific type, *i.e.*, an implant having expansion elements as in Fig. 4e, into the disc. As explained above, independent claim 12 has been amended to require that the method consists essentially of the steps of ... “inserting no more than one implant into the defect in the annulus fibrosis.” Baumgartner requires several

implants. These additional implants required in Baumgartner materially affect the basic properties of the claimed method. Therefore, Baumgartner is outside the scope of claim 12.

Claim 12 is therefore patentably distinct from the cited references. Each of claims 13 and 16-18 are dependent on claim 12 and therefore are patentably distinct from the cited references for the same reasons applicable to claim 12. The rejections under §§ 102 and 103 should therefore be withdrawn.

For all the foregoing reasons, Applicant asserts the claims are in condition for allowance. Favorable action on the merits of the claims is therefore earnestly solicited. If any issues remain, please contact Applicant's undersigned representative at (949) 760-9600. The Commissioner is hereby authorized to charge any additional fees that may be required to Deposit Account No. 50-2862.

Respectfully submitted,
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